



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/499,069	02/04/2000	Ted Eugene Wright	77017.002	9708

7590 10/06/2003

ROBERT BERGSTROM  
BLACK LOWE & GRAHAM PLLC  
816 SECOND AVENUE  
SEATTLE, WA 98104

EXAMINER

CARTER, MONICA SMITH

ART UNIT PAPER NUMBER

3722

DATE MAILED: 10/06/2003

31

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/499,069

Applicant(s)

WRIGHT, TED EUGENE

Examiner

Monica S. Carter

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/21/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The declaration filed August 5, 2002 along with the exhibits filed July 21, 2002 have been reviewed; however, this issue is moot in view of the newly cited rejections below.

#### ***Claim Objections***

1. Claims 5 and 16 are objected to because of the following informalities:

In claim 5, last line, the proper punctuation is missing at the end of the sentence.

In claim 16, line 6, the recitation "separated the registration" appears to be incomplete.

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Thompson ('119).

Thompson discloses a ticket envelope (10) comprising a registration form (18); an unfolded key packet (combination of 14 and 16) separated from the registration form by a line of perforations (40), the unfolded key packet including at most two perforations (30, 36) that allow unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps (wherein the first step would be along perforation 30 and the second step would be along perforation 36); and a die-cut slot

Art Unit: 3722

(42) in the unfolded key packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like - see col. 3, lines 2-8; inherently, this would include keys).

Regarding claim 7, Thompson discloses including a number of items (see col. 3, lines 2-8) which would, inherently, include keys consisting of metal keys and magnetic keys. It is further noted that the keys do not structurally limit the registration form and key packet.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson.

Regarding claim 2, Thompson discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a pre-printed registration form and key packet since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate it will not distinguish the invention from the prior art in terms of patentability. *In re Gulack*, 217 USPQ 401, (CAFC 1983). The fact that the

content of the printed matter placed on the substrate may render the device more convenient by providing an individual with a specific type of registration form and key packet does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Thus, there is no novel and unobvious functional relationship between the printed matter and the substrate which is required for patentability.

Regarding claim 5, Thompson discloses the envelope being rectangular (as seen in figure 1). Thompson further discloses that the registration form comprises the top portion of the registration form and key packet and the registration form is separated from the unfolded key packet by a horizontal line of perforations (viewing the envelope in figure 1 at a ninety degree angle would provide the horizontal line of perforations separating the top portion having the form from the bottom portion having the key packet). Thompson discloses the claimed invention except for the registration form and key packet having a greater vertical dimension than a horizontal dimension. It would have been an obvious matter of design choice to provide any desired dimensions for the registration form and key packet, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

6. Claims 3, 4 and 11-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thompson, as used above, in view of Crowell (4,592,573).

Regarding claims 3, 4, 11, 13-16, and 18-20, Thompson discloses a ticket envelope (10) comprising a registration form (18); an unfolded key packet (combination of 14 and 16) separated from the registration form by a line of perforations (40), the unfolded key packet including at most two perforations (30, 36) that allow unfolded key packet to be quickly and accurately folded into a complete key packet in two or fewer steps (wherein the first step would be along perforation 30 and the second step would be along perforation 36); and a die-cut slot (42) in the unfolded key packet which serve as a slot to hold a number of items (i.e., travel tickets, receipt stubs, coupons and the like - see col. 3, lines 2-8; inherently, this would include keys).

Thompson discloses the claimed invention except for explicitly disclosing the registration form and key packet being printed on a printing device (commercially available computer laser printer).

Crowell discloses a foldable sheet (30) that can be printed on by a computer printer (to, inherently, include laser printers) (see col. 2, lines 45-51). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Thompson's invention to include pre-printing information on the envelope by way of a computer printer, as taught by Crowell, to provide the envelope with advertising indicia and other related information to convey information to the user of the envelope.

Regarding claims 12 and 17, Thompson, as modified by Crowell, discloses the registration form and key packet being made of any suitable paper stock (see col. 1, lines 63-66 of Thompson).

Regarding claim 20, Thompson, as modified by Crowell, discloses the single sheet being rectangular (as seen in figure 1 of Thompson).

### ***Allowable Subject Matter***

7. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1-7 and 11-21 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monica S. Carter whose telephone number is (703) 305-0305. The examiner can normally be reached on Monday-Thursday (7:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea L. Wellington can be reached on (703) 308-2159. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Application/Control Number: 09/499,069

Page 7

Art Unit: 3722

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

  
MONICA S. CARTER  
PRIMARY EXAMINER

September 30, 2003